

Remark:**(A) Background information:**

1. The subject application was first filed on 10/09/1998 as application 09/169,462.
2. According to an interview with the examiner by that time, the application was revised as a FWC application on 10/16/1999 and claiming application 09/169,462 on priority.
3. Accordingly the examination process of the subject applicant had recently **"exceeded ten years"**.
4. During the past ten years, the standard test of compliance to 35 U.S.C. 101 had been continuously changing as follow:
 - (a) Pre-computer activities and post computer activities tests. This were the standard tests of 35 U.S.C. 101 eligibility by the time the application was filed. The specification and claims of the subject application was written according to fulfill these test requirements.
 - (b) When the examination process was handed over to examiner Armstrong seven years later, the standard test of the time was "useful, concrete and tangible result" tests. The subject claims had then been amended to comply with the new requirements.
 - (c) During the previous Interaction with examiner Armstrong, a new "storage media" requirement was introduced. The subject claims had then been amended again to comply with the new direction provided by the examiner.
 - (d) In the latest office action dated 08/20/2008, the examiner introduced another new set of tests (1) tie to another statutory class of invention requirement; or (2) transform subject matter to another state or thing tests.
 - (e) While the applicant was struggling how to amend the subject claims and specification without introducing new matters in order to comply with the requirements newly introduced by the examiner, the United States Court of Appeals for the Federal Circuit handed down a fresh new en banc governing precedent case In re Belski 2007-1130 (Serial No. 08/833,892). This case decided on 10/30/2008 provided another new set of tests to determine eligibility of 35 U.S.C. 101. The latest standard tests determined by the In re Belski Court was that a process is eligible when:
 - (i) it is tied to a particular machine or apparatus, or

- (ii) it transforms a particular article into a different state or thing.
5. Since the applicant had been amending the subject claims several times during the past ten years in order to comply with the "continuously changing" compliance standard of 35 U.S.C. 101, the content of the subject claims now contained wording no longer valued by the examination standard. Accordingly a substantial amendment of the subject claims is now required to recall limitations added to comply with previous (now non-applicable) requirements. The subject claims are amended to comply with the latest tests set by the en banc In re Belski Court.
 6. The specification is also amended to provide precedent to support the amended subject claim according to the direction of the In re Belski Court. The examiner is respectfully directed to note that the amendment of the specification was due to the continuously changing examination requirements of the patent examination standard during the past ten years. **This was not a fault of the applicant.** If the PTO was able to honor a timely examination process deserved by the applicant ten years ago, the subject amendment of claims and specification would not had been required. After some very difficult work, the applicant was able to provide adequate legal support to the subject specification amendment without introducing new matters. Understanding and courtesy of the examiner to approve the amendment of the subject claims and specification was respectfully solicited.
 7. According to the Dissents provided by three federal judges in the precedent case In re Belski, the applicant had a feeling that the famous precedent Court ruling State Street Bank and Trust v. Signature Financial Group had been questioned. Although a new set of tests had been provided by the Court, the standard may be further changed when new cases are submitted to the United States Court of Appeals for the Federal Circuit or the Supreme Court in future time. Accordingly the examiner is respectfully requested to examine the subject claims according to the teaching of the In re Belski Court. The examination process is respectfully requested to be conducted as soon as possible so as to avoid repeating the problem when new test standards are introduced by the Court.

(B) Important precedent Court ruling:

The major supporting precedent Court ruling is In re Belski freshly decided on October 31, 2008. The In re Belski Court provided extensive detail about compliance of 35 U.S.C. 101 as follow:

- (1) The "Technology Art" test previously implemented by PTO was not a valid test. A process is eligible for patent protection under 35 U.S.C. 101 if
- (i) it is tied to a particular machine or apparatus, or
 - (ii) It transforms a particular article into a different state or thing.

On page 29, the Court decision recited that:

..... Neither the PTO nor the Courts may pay short shift to the machine-or-transformation test by using purported equivalents or shortcuts such as "technology arts" requirement. Rather, the machine-or-transformation test is the only applicable test and must be applied, in light of the guidance provided by the Supreme Court and this Court, when evaluating the patent-eligibility of process claims.

- (2) Use of abstract idea, law of nature or a mathematical equation into a specific application may well be deserving of patent protection. When a claim at issue did not pre-empt all uses of a mathematical equation is an evidence to comply with 35 U.S.C. 101. In pages 7-16 in the decision of *In re Belski*, the Court cited US Supreme Court precedent *Diamond v. Diehr*, 450 U.S. 175 (1981) and conclude that by restricting to a particular machine, the use of a non-eligible subject matter such as a mathematical equation into a particular machine, does not pre-empt all uses of the equation, and therefore passing the test to comply with 35 U.S.C. 101. In the case of *Diehr*, the particular machine tied to is an injection molding machine.
- (3) In evaluating a 35 U.S.C. 101 issue, the claim should be considered as a whole. On page 17-18 of the *In re Belski* decision, the Court recited that:

Second, the Court has made clear that it is inappropriate to determine the patent eligibility of a claim as a whole based on whether selected limitations constitute patent eligibility subject matter..... Diehr, 450 U.S. at 188 ("it is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.").

Furthermore, In pages 18-19 of the *In re Belski* decision, the Freeman-Walter-Abele test used by some examiners is ruled by the Court as not appropriate to determine if a claim complies with 35 U.S.C. 101.

- (4) The In re Belski Court further clarified in page 22 of the decision a misunderstanding of previous Court decision Comiskey to imply a new 101 test that bars any claim reciting a mental process that lacks significant "physical steps". The court specifically pointed out that **the machine-or-transformation test should be the only test to determine a claim drawn to patent eligible subject matter.**
- (4) Data is a type of article to be transformed, transformation of data into a different state of data in the application was sufficient to meet the transformation requirement of 35 U.S.C. 101. On page 25-26, the In re Belski Court ruled that:

The raw materials of many information-age processes, however, are electronic signals and electronically-manipulated data.....We further note for clarity that the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.

(C) Amendment of the claims:

(1) Independent claim 86:

Claim 86 claimed a machine. It recites characteristics of a machine named as a programming tool. As understood by a person having ordinary knowledge in the art, and as further defined in the specification, a programming tool is a tool, or a machine that enables a programmer to write a program for a computing device. It is analogous to a typewriter that is a tool or a machine for a user to write a letter. Accordingly a programming tool is a real world article that belongs to the category of machine, a statutory class of invention under 35 U.S.C. 101. The applicant agrees with the office action that a programming tool is not a process, nor a composition of matter. However, the applicant does not agree with the office action to merely say that a programming tool is not a machine **without providing supporting reason how this conclusion is drawn.** In his response dated 06/19/2007, the applicant respectfully submitted an **EVIDENCE** with the system of EM57000 as a typical example of a machine – the programming tool recited in claim 86. When compared with the discussion of section (B)(3) above, the recitation of a programming tool is an old element of the claim that satisfies the eligibility requirement of 35 U.S.C. 101. Discussion of section (B)(4) above indicated that the office action erred to merely use the table format characteristics of the programming tool to exclude a machine – the

programming tool from the eligibility of statutory class without consider the subject claim limitations as a whole. When section (B)(1) discussed above is considered, the subject claim is tied to a machine that enables a programmer to program a computing device. If the ground of rejection of claim 86 is to be withheld, the examiner is respectfully requested to provide reasonable **EVIDENCE** proofing that a programming tool or machine, or the EM57000 example of a programming tool is **NOT** a machine under the statutory class of 35 U.S.C. 101.

- (2) Independent claims 92, 114, 120, 135, 148, 154, 170 and 175 are now amended to "tie" a process limitation to a specific machine - a programming machine that enables a programmer to program a computing device. A further limitation is added in each independent claim to specifically point out that the data representing the configuration states and paths claimed are then "transformed" into data executable by the computing devices. The teaching of the fresh precedent court ruling clearly indicated that any one of the two conditions indicated in section (B)(1) above will enable a claim to satisfy the requirement of 35 U.S.C. 101. It is respectfully submit that each of the claims 92, 114, 120, 135, 148, 154, 170 and 175 are now amended to satisfy **BOTH** tests defined by the Court of In re Belski, as discussed in sections (B)(1) and (B)(5) above. Accordingly, withdrawal of the ground of rejection to the subject claims is respectfully requested.

(D) Amendment of the specification:

The specification is also amended to high light the machine to be "tied" by the process claim according to the teaching of precedent court ruling In re Belski. Since the subject claims are amended to satisfy the two test requirements provided by the Court In re Belski, the specification are required to be amended to provide adequate antecedent supporting the claim language that is required by the new teaching of the In re Belski Court. The specification was amended to provide an art recognized definition of the term "programming tool". This amendment is also supported in various further descriptions of the specification. Greatest care had been taken not to introduce new matter into the subject specification. Listed below is a recitation of MPEP 2163.07 I:

Rephrasing, Dictionary or art recognition definition of term is not new matter

The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., Scarring Corp. v. Megan, Inc., 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000)

Accordingly providing an art recognized definition to a term to provide antecedent support to a claim amendment made according to the new Court teaching is not a new matter.

In order to facilitate a person having ordinary knowledge in the art to better understand the detail nature of the machine to be "tied" by the process claim, the definition of the machine is also amended at the same paragraph to include different programming tool structures "that are local or remote from the computing device to be programmed". This recitation merely repeats the description provided in page 12, first paragraph of the original specification and therefore not a new matter.

Finally, the examiner is also respectfully requested to provide suggested amendment according to MPEP 707.07(j) if further amendment of the subject application is required in order to overcome the rejection of 35 U.S.C. 101.

[End of Remark]